

TO: Mail Stop 8 Director of the U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court Northern District of California on the following ☒ Patents or ☐ Trademarks:

DOCKET NO. C-09-1703-BZ	DATE FILED 4/17/2009	U.S. DISTRICT COURT Office of the Clerk, 450 Golden Gate Ave., 16th Floor, San Francisco, CA 94102
PLAINTIFF FIRE INNOVATIONS, LLC		DEFENDANT RIT RESCUE & ESCAPE SYSTEMS, INC.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 5,970,517		
2 6,487,725		
3 7,086,091		"Pls. See Attached Copy of Complaint".
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK Richard W. Wieking	(BY) DEPUTY CLERK Thelma Nudo	DATE April 17, 2009
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

1 i. The patent was issued without due investigation, relevant prior art was
2 overlooked, and other relevant prior art was improperly construed and applied, and therefore the
3 Commissioner of Patents exceeded his authority in granting such patent; and

4 j. The purported combination patent claims in suit are invalid in that they are
5 merely an aggregation of old elements, well-known in the art to which such patent relates before
6 the alleged invention and more than one year prior to the filing of the application for such patent.

7 29. As and for a Second Cause of Action, Fire Innovations therefore desires and seeks a
8 judicial determination and declaration of the respective rights and duties of the parties on the
9 dispute recited above. Such a determination and declaration are necessary and appropriate at this
10 time so that the parties may ascertain their respective rights and duties regarding the '517 patent.

11
12 THIRD CAUSE OF ACTION
13 DECLARATION OF NON-INFRINGEMENT OF THE '091 PATENT

14 30. Fire Innovations realleges and incorporates by reference all of the allegations of
15 paragraphs 1 through 29, as if set forth fully herein.

16 31. Fire Innovations does not make, use, sell, offer for sale, or import for sale any
17 product that infringes any claim of the '091 patent, either directly or indirectly, literally or under
18 the doctrine of equivalents.

19 32. As and for a Third Cause of Action, Fire Innovations therefore seeks a judicial
20 determination and a declaratory judgment that Fire Innovations does not infringe, either directly
21 or indirectly, literally or under the doctrine of equivalents, the claims of the '091 patent. Such a
22 determination and declaration are necessary and appropriate at this time so that the parties may
23 ascertain their respective rights and duties regarding the '091 patent.

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FOURTH CAUSE OF ACTION
DECLARATION OF INVALIDITY OF THE '091 PATENT

33. Fire Innovations realleges and incorporates by reference all of the allegations of paragraphs 1 through 32, as if set forth fully herein.

34. On information and belief, the '091 patent, and each claim thereof, are invalid for failure to comply with the conditions and requirements of patentability set forth in Title 35 of the United States Code, particularly 35 U.S.C. §§ 101 et seq., including, but not limited to 35 U.S.C. §§ 101, 102, 103 and 112.

35. On information and belief, the '091 patent, and each claim thereof, are limited in scope, and are invalid and void, for the following reasons:

a. The alleged invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the alleged invention thereof by the applicant for such patent;

b. The alleged invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for such patent in the United States;

c. The alleged invention was described in a patent granted on an application for patent by another filed in the United States before the alleged invention thereof by the applicant for such patent, or on an international application by another who fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of 35 United States Code before the alleged invention thereof by the applicant for such patent;

d. The applicant for such patent did not himself invent the subject matter sought to be patented;

e. Before the applicant's alleged invention thereof, the invention was made in this country by another who had not abandoned, suppressed, or concealed it;

1 f. Any differences between the subject matter of the claims of such patent and the
2 prior art are such that the subject matter as a whole would have been obvious at the time the
3 alleged invention was made to a person having ordinary skill in the art to which the subject
4 matter pertains;

5 g. The specification of such patent does not contain a written description of the
6 alleged invention and of the manner and process of making and using it, in such full, clear,
7 concise, and exact terms as to enable any person skilled in the art to which it pertains, or with
8 which it is most nearly connected, to make and use the same, and does not set forth the best mode
9 contemplated by the applicant for carrying out his invention;

10 h. The claims of such patent are functional, vague, and indefinite, are broader
11 than the alleged invention as set forth in the specification, and do not particularly point out and
12 distinctly claim the subject matter, which applicant regards as his alleged invention;

13 i. The patent was issued without due investigation, relevant prior art was
14 overlooked, and other relevant prior art was improperly construed and applied, and therefore the
15 Commissioner of Patents exceeded his authority in granting such patent; and

16 j. The purported combination patent claims in suit are invalid in that they are
17 merely an aggregation of old elements, well-known in the art to which such patent relates before
18 the alleged invention and more than one year prior to the filing of the application for such patent.

19 36. As and for a Fourth Cause of Action, Fire Innovations therefore desires and seeks a
20 judicial determination and declaration of the respective rights and duties of the parties on the
21 dispute recited above. Such a determination and declaration are necessary and appropriate at this
22 time so that the parties may ascertain their respective rights and duties regarding the '091 patent.

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FIFTH CAUSE OF ACTION
DECLARATION OF UNENFORCEABILITY OF THE '571 PATENT

37. Fire Innovations realleges and incorporates by reference the allegations of paragraphs 1 through 36 above, as if fully set forth herein.

38. On information and belief, RIT and/or the inventor and/or their respective authorized representatives withheld material prior art during the prosecution of the '571 patent with the intent to mislead the USPTO.

39. On information and belief, the prior art withheld by the RIT and/or the inventor and/or their respective authorized representatives includes numerous fire rescue and safety equipment products on sale in the United States more than one year before the filing date of the application for the '571 patent.

40. On information and belief, RIT and/or the inventor and/or their respective representatives had knowledge of the such prior art products, as well as other materially relevant prior art products, and withheld information concerning these products with the intent to mislead the USPTO.

41. As a result of RIT's and/or the inventor's and/or their respective authorized representative's inequitable conduct during prosecution, the '571 patent and all the claims thereof are unenforceable.

42. The '571 patent is unenforceable because RIT has misused such patent, and has so used such patent in violation of the antitrust laws, and has unclean hands, in that such patent is being asserted in an attempt to improperly restrain trade in unpatentable products.

43. As and for a Fifth Cause of Action, Fire Innovations therefore desires and seeks a judicial determination and declaration of the respective rights and duties of the parties on the dispute recited above. Such a determination and declaration are necessary and appropriate at this time so that the parties may ascertain their respective rights and duties regarding the '571 patent.

SIXTH CAUSE OF ACTION
DECLARATION OF UNENFORCEABILITY OF THE '091 PATENT

44. Fire Innovations realleges and incorporates by reference the allegations of paragraphs 1 through 43 above, as if fully set forth herein.

45. On information and belief, RIT and/or the inventor and/or their respective authorized representatives withheld material prior art during the prosecution of the '091 patent with the intent to mislead the USPTO.

46. On information and belief, the prior art withheld by the RIT and/or the inventor and/or their respective authorized representatives includes numerous fire rescue and safety equipment products on sale in the United States more than one year before the filing date of the application for the '091 patent.

47. On information and belief, RIT and/or the inventor and/or their respective representatives had knowledge of the such prior art products, as well as other materially relevant prior art products, and withheld information concerning these products with the intent to mislead the USPTO.

48. As a result of RIT's and/or the inventor's and/or their respective authorized representative's inequitable conduct during prosecution, the '091 patent and all the claims thereof are unenforceable.

49. The '091 patent is unenforceable because RIT has misused such patent, and has so used such patent in violation of the antitrust laws, and has unclean hands, in that such patent is being asserted in an attempt to improperly restrain trade in unpatentable products.

50. As and for a Sixth Cause of Action, Fire Innovations therefore desires and seeks a judicial determination and declaration of the respective rights and duties of the parties on the dispute recited above. Such a determination and declaration are necessary and appropriate at this time so that the parties may ascertain their respective rights and duties regarding the '571 patent.

SEVENTH CAUSE OF ACTION
UNFAIR COMPETITION AND FALSE DESCRIPTION UNDER 15 U.S.C. § 1125(A)(1)

51. Fire Innovations realleges and incorporates by reference the allegations in paragraphs 1 through 50 above, as if fully set forth herein.

52. Fire Innovations is actively involved in the design, development, manufacture, marketing, and sale, of innovative fire safety products and systems.

53. On information and belief, Fire Innovations alleges that RIT is a direct competitor of Fire Innovations in this business field and offers its own products, as well as those of others, in the same channels of trade and distribution in which the Fire Innovations products are marketed and sold.

54. In the early part of 2008, Fire Innovations commenced discussions with a number of prospective customers to offer for sale a newly invented quick release system for use with a self-contained breathing apparatus, which quick release system was offered in combination with operationally complementary waist belt and rapid egress escape system.

55. In and around the months of April and May 2008, knowing that agreements were nearly concluded between Fire Innovations and one or more prospective purchasers of Fire Innovations' products, RIT willfully, and with the intent to damage Fire Innovations, made numerous false and disparaging statements to the prospective purchasers concerning Fire Innovations and Fire Innovations products.

56. By engaging in the activities described above, RIT has made and is making false, deceptive, and misleading statements constituting unfair competition and false representations made in connection with products sold and distributed in interstate commerce in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

57. RIT's acts of unfair competition have caused and are causing great and irreparable injury to Fire Innovations and its business reputation, in an amount that cannot be ascertained at

1 this time and, unless restrained, will cause further irreparable injury, leaving Fire Innovations
2 with no adequate remedy at law.

3 58. By reason of the foregoing, and as and for a Seventh Cause of Action, Fire
4 Innovations is seeking injunctive relief against RIT, restraining further acts of unfair competition
5 and false representations, and is further seeking a recovery of attorneys' fees and any damages
6 proven to have been caused by reason of RIT's aforesaid acts of unfair competition and false
7 advertising.

8
9 EIGHTH CAUSE OF ACTION
10 INTERFERENCE WITH PROSPECTIVE BUSINESS ADVANTAGE

11 59. Fire Innovations realleges and incorporates by reference the allegations of paragraphs
12 1 through 58 above, as if fully set forth herein.

13 60. Fire Innovations' business relationships with the prospective purchasers referred to in
14 Paragraph 54, above, was designed to result in economic benefit to Fire Innovations.

15 61. RIT's wrongful acts and conduct in making false and disparaging statements about
16 Fire Innovations and Fire Innovations' products to prospective purchasers of such products had
17 the purpose and effect of interfering with Fire Innovations' business and contractual relations,
18 and of depriving it of existing and prospective business advantage. RIT's wrongful conduct
19 caused persons, legal and natural who might reasonably have been expected to enter into
20 advantageous business arrangements and contracts with Fires Innovations not to do so, or to do
21 so to a lesser extent or on terms less advantageous to Fire Innovations than would have been the
22 case in the absence of RIT's wrongful conduct.

23 62. RIT engaged in the foregoing conduct intentionally, maliciously, unjustifiably,
24 willfully, wantonly, recklessly, and in conscious, deliberate, and utter disregard of Fire
25 Innovations' rights.

1 63. By reason of the foregoing, and as and for an Eighth Cause of Action, Fire
2 Innovations is seeking injunctive relief against RIT, restraining it from further acts of
3 interference with Fire Innovations's prospective economic advantage, and is further seeking to
4 recover attorneys' fees and any damages proven to have been caused by reason of RIT's aforesaid
5 acts of interference.

6
7 NINTH CAUSE OF ACTION
8 DECEPTIVE TRADE PRACTICES,
9 CALIFORNIA BUS. & PROF. §17500 ET SEQ

10 64. Fire Innovations realleges and incorporates by reference the allegations of paragraphs
11 1 through 63 above, as if fully set forth herein

12 65. This Court has jurisdiction of this cause of action pursuant to 28 U.S.C. §§ 1367(a),
13 and Venue is proper under 28 U.S.C § 1391(b) and (c).

14 66. RIT has engaged in deceptive trade practices and has disparaged the goods, services,
15 and/or business of Fire Innovations by false representation of fact.

16 67. RIT's wrongful acts and conduct had the purpose and effect of interfering with Fire
17 Innovations' business and contractual relations, and of depriving it of existing and prospective
18 business advantage. RIT's wrongful conduct caused persons, legal and natural who might
19 reasonably have been expected to enter into advantageous business arrangements and contracts
20 with Fires Innovations not to do so, or to do so to a lesser extent or on terms less advantageous to
21 Fire Innovations than would have been the case in the absence of RIT's wrongful conduct.

22 68. RIT engaged in the foregoing conduct intentionally, maliciously, unjustifiably,
23 willfully, wantonly, recklessly, and in conscious, deliberate, and utter disregard of Fire
24 Innovations' rights.

25 69. By reason of the foregoing, and as and for a Ninth Cause of Action, Fire Innovations
26 is seeking injunctive relief against RIT, restraining it further acts of deceptive trade practices, and

1 is further seeking to recover attorneys' fees and any damages proven to have been caused by
2 reason of RIT's aforesaid acts of interference.

3
4 TENTH CAUSE OF ACTION
5 DECLARATION OF EXCEPTIONAL CASE

6 70. Fire Innovations realleges and incorporates by reference herein the allegations as set
7 forth in paragraphs 1 through 69 above, as if fully set forth herein.

8 71. As and for a Tenth Cause of Action, Fire Innovations seeks to have this declared and
9 adjudged as exceptional under 35 U.S.C. § 285, and thus to have awarded its attorneys' fees and
10 expenses relating to the pursuit of this action. As proof of exceptional case status, Fire
11 Innovations expects to prove the allegations set forth in paragraphs 51 through 69, and to show
12 that RIT filed the action in Ohio without a reasonable basis in law or fact to support its
13 allegations of infringement of any of the patents that were the subject of that suit, and further that
14 RIT's bad faith is demonstrated by, among other things, spreading false accusations of
15 infringement among Fire Innovation's customers with intent to injure Fire Innovations.

16
17 RELIEF REQUESTED

18 WHEREFORE plaintiff submits that it is entitled to judgment and respectfully prays as
19 follows:

20 A. That defendant, RIT's, patents and the claims in suit thereof be adjudged invalid, void,
21 and unenforceable;

22 B. That it be adjudged that devices manufactured, offered to be sold, and sold by Plaintiff,
23 Fire Innovations, have not infringed and do not infringe defendant's patents;

24 C. That defendant be enjoined from asserting such patents against plaintiff, its
25 representatives, agents, customers, and contractors, present and prospective;

1 D. That defendant account to Fire Innovations and be assessed an amount to recompense
2 Fire Innovations for defendant's harassing of plaintiff and the resulting loss to plaintiff;

3 E. That a preliminary injunction be entered enjoining defendant, RIT, its officers,
4 employees, agents, servants, and attorneys, and those persons in active concert or participation
5 with it who receive actual notice thereof from initiating infringement litigation and from
6 threatening Fire Innovations or any of its customers, dealers, agents, servants, or employees, or
7 any prospective or present sellers, dealers, or users of any presently existing Fire Innovations'
8 fire safety and rapid egress products with infringement litigation or charging any of them either
9 verbally or in writing with infringement of the '571 and/or '091 patents because of the use or
10 selling or offering for sale of the presently existing Fire Innovations fire safety and rapid egress
11 products, such injunction being made permanent following trial.

12 F. That defendant has misused its patents in violation of the antitrust laws;

13 G. That Fire Innovations be awarded its costs, disbursements and attorney's fees incurred
14 in this action pursuant to 35 U.S.C. § 285, and other provisions of law; and

15 H. That Fire Innovations be granted such other and further relief as this Court may deem
16 just.

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24 *[Remainder of page intentionally left blank.]*

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Attorneys for Plaintiff
FIRE INNOVATIONS, LLC

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

FIRE INNOVATIONS, LLC
(a California limited liability company)
Plaintiff

vs.

RIT RESCUE & ESCAPE SYSTEMS, INC.
(an Ohio corporation)
Defendant.

CASE NO.

CV

09

1703

COMPLAINT FOR DECLARATORY
JUDGMENT OF PATENT INVALIDITY AND
NON-INFRINGEMENT OF UTILITY PATENT
AGAINST OWNER, FOR UNFAIR
COMPETITION AND FALSE DESCRIPTION,
INTERFERENCE WITH PROSPECTIVE
BUSINESS ADVANTAGE, DECEPTIVE TRADE
PRACTICES, AND JURY DEMAND

COMPLAINT

Plaintiff alleges:

JURISDICTION AND VENUE

1. This action arises under the United States patent laws, Title 35 of the United States Code, and the provisions for declaratory judgment under §§ 2201-2202 of Title 28 of the United States Code. This Court therefore has jurisdiction under 28 U.S.C. §§ 1331, 1338.

*Complaint for Declaratory Judgment of Patent Invalidity
and Non-Infringement of Utility Patent Against Owner,
for Unfair Competition and False Description, Interference
with Prospective Business Advantage, Deceptive Trade Practices,
and Jury Demand*

ORIGINAL
FILED

APR 17 2009

RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT,
NORTHERN DISTRICT OF CALIFORNIA

E-filing

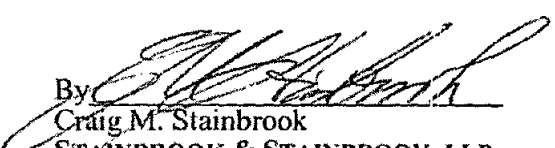
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1 DEMAND FOR JURY TRIAL

2 Fire Innovations hereby demands trial by jury of all issues.

3
4 DATED: April 17, 2009

Respectfully submitted,

5
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14 Attorneys for Plaintiff
15 FIRE INNOVATIONS, LLC
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1 2. Venue for this action is proper in this district. pursuant to the Judiciary and Judicial
2 Procedure Laws of the United States, 28 U.S.C. § 1391.

3
4 THE PARTIES

5 3. Plaintiff, Fire Innovations, LLC, ("Fire Innovations") is a limited liability company
6 formed and existing under the laws of the State of California, and has its principal place of
7 business at 2454 E. Washington Street, Petaluma, California 94954.

8 4. Defendant, RIT Rescue & Escape Systems, Inc., ("RIT") is a corporation formed and
9 existing under the laws of the State of Ohio, and has its principal place of business at 1900
10 Enterprise Parkway, Suite H, Twinsburg, Ohio 44087.

11
12 INTRADISTRICT ASSIGNMENT

13 5. Pursuant to Civil Local Rule 3-2 (c), this action is an Intellectual Property Action that
14 may be assigned on a district-wide basis.

15
16 BACKGROUND FACTS

17 6. Fire Innovations has been and is currently engaged in the design, manufacture, and
18 sale of innovative products relating to firefighter safety and work requirements, including such
19 apparatus as trucker's belts and harness systems; rope bags and bailout systems; belt attachments
20 and accessories; wildland gear, tethers, and hose packs; large area search systems; tool holsters;
21 tool pouches; and respiratory protection equipment, such as face and breathing shrouds, and
22 smoke masks, and the like.

23 7. Fire Innovations has sought to enter into manufacturing agreements with various
24 companies involved in the manufacture and sale of self-contained breathing apparatus ("SCBA")
25 for use by firefighters and rescue personnel, including several of the largest manufacturers and
26 sellers of such equipment. Fire Innovations has been successful in concluding an original

1 equipment manufacturing agreement ("OEM Agreement") with one such manufacturer under
2 which Fire Innovations would customize and tailor firefighter utility belts and rapid
3 egress/bailout systems for inclusion in the manufacturer's SCBA. The OEM Agreement is
4 confidential in its terms but includes among its various provisions a mutual indemnification
5 clause that provides, in pertinent part, that each party shall defend and indemnify the other party
6 against claims that any designs, specifications, or material furnished by the provider and used by
7 the recipient in an authorized manner infringes any patent right of a third party.

8 8. On information and belief, Defendant, RIT, is engaged in the manufacture and sale of
9 firefighter safety systems, such as: turn out gear; emergency egress and bailout systems; search
10 systems; belts and harnesses; hardware for climbing and descending with the use of ropes; body
11 harnesses for use with self-contained breathing apparatus; and miscellaneous products relating to
12 the each of the foregoing product types. It has sales of such products at least nationwide
13 throughout the United States, and it is a direct competitor with Fire Innovations with respect to
14 certain of its products, including rapid egress and bailout systems adapted for connection to body
15 harnesses used by firefighters and rescue personnel.

16 9. On information and belief, RIT is the record assignee and sole owner of United States
17 Patent No. 5,970,517, issued October 26, 1999, for a Safety Harness with Integral Support Line,
18 to Omar P. Jordan (hereinafter referred to as "the '517 patent").

19 10. On information and belief, RIT is the record assignee and sole owner of United
20 States Patent No. 6,487,725, issued December 3, 2003, for a Safety Harness with Integral
21 Support Line, to Omar P. Jordan (hereinafter referred to as "the '725 patent").

22 11. On information and belief, RIT is the record assignee and sole owner of United
23 States Patent No. 7,086,091, issued August 8, 2006, for a Full Body Harness, to Omar P. Jordan
24 (hereinafter referred to as "the '091 patent").

25 12. The '571 patent and the '091 patent are collectively referred to herein as the "patents
26 in suit."

1 13. RIT, in letters to Fire Innovations sent on or about July 20, 2007, and again on
2 December 10, 2007, represented that it was the owner of each of the above-indicated patents and
3 alleged that certain of plaintiff's products constitute an infringement of such patents. Fire
4 Innovations denied any infringement, but despite repeated requests by Fire Innovations in
5 subsequent correspondence to defendant, RIT declined to provide any indication of which
6 products, if any, manufactured and/or sold by Fire Innovations infringed any of the RIT patents.
7 Instead, rather than provide Fire Innovations with an indication of which of plaintiff's products
8 infringed any one or more of the RIT patents, and without having conducted a legally reasonable
9 pre-filing investigation of infringement, RIT filed suit against plaintiff in Federal District Court,
10 Northern District of Ohio, Case No. 1:08-cv-1101-DP.

11 14. After more than a year of litigation, RIT failed to discover or to produce any evidence
12 that Fire Innovations infringed any claim in the '571, the '725, or the '091 patents. Further,
13 despite discovery propounded by Fire Innovations for the purpose of learning the factual and
14 legal bases for RIT's claims of infringement, RIT failed entirely to provide any responsive
15 answers or to articulate the factual and legal bases for its claims. Further still, RIT filed a claims
16 chart with the Court that failed to meet well-established criteria for properly asserting a claim as
17 infringed; specifically, it provided no element-by-element mapping of the asserted claims on the
18 allegedly infringing instrumentality(ies). Even so, it asserted that at least one claim in each of the
19 subject patents was being infringed by Fire Innovations. From the claims chart it was impossible
20 to ascertain how RIT was reading the asserted claims on the allegedly infringing
21 instrumentalities.

22 15. Having undergone a nearly a year in litigation and still having received no indication
23 from RIT of the grounds for the action, Fire Innovations sought Court intervention to compel RIT
24 to provide proper discovery responses and to provide a detailed claims chart in substantial
25 conformity with the standards set out in Patent Local Rule 3-1 for the Northern District of
26 California.

1 16. Rather than provide a statement of the bases for its claims, RIT instead sought to
2 dismiss the case without prejudice. It expressly stated to the Court that instead of continuing its
3 action against Fire Innovations, it wished to pursue an action in another jurisdiction against the
4 Fire Innovations customer referred to in paragraph 7, above. In a motion to amend its complaint,
5 RIT admitted that based on the then currently available information, Fire Innovations was not
6 infringing the '517 or the '091 patents. However, it asserted that Fire Innovations' customer did
7 appear to be manufacturing and offering for sale a product that infringes the '091 patent. RIT
8 made this representation despite the fact that the factual basis for such a claim would be the sale
9 and offer for sale by that customer of an SCBA system that included the very products made and
10 sold to it by Fire Innovations and that ostensibly gave rise to the action in Ohio in the first place.

11 17. As part of its effort to effect a dismissal without prejudice, RIT initiated its own
12 Request for Reexamination of one of the patents in suit, namely, the '725 patent. On information
13 and belief, a decision on RIT's reexamination request is currently pending before the United
14 States Patent Office.

15 18. At the time defendant initiated its effort to have its action in Ohio dismissed, it knew
16 of the OEM Agreement that Fire Innovations had concluded and of the fact that the OEM
17 Agreement included the indemnification clause described in Paragraph 7, above.

18 19. On March 19, 2009, the action in Ohio was dismissed without prejudice. The order
19 provided that the dismissal was granted on several conditions, including:

20 a. "RIT shall cooperate with the U.S. Patent Office in processing the
21 reexamination of the '725 patent, and will not refile any claims related to that patent against Fire
22 Innovations until the Patent Office has completed its reexamination;

23 b. Any claims brought by RIT against Fire Innovations in the future shall be
24 refiled in California.

1 c. Any claims that RIT files against Fire Innovations in the future relating to the
2 571, '091, and/or '725 patents shall be accompanied by a legally sufficient claim chart as to all
3 alleged patent infringements;

4 d. Both RIT and Fire Innovations may use all pleadings and documents filed,
5 discovery responses and correspondence in this case in any new cases;

6 e. The aforementioned conditions shall apply as well to any claims RIT brings
7 against [Fire Innovations' customer] in the future relating to the '571, '091 and '725 patents."

8 20. RIT moved to have the Court's Stipulated Dismissal Order amended or modified to
9 allow it to sue Fire Innovations' customer in Rhode Island, but the Court denied the motion and
10 upheld its earlier Order, including all of the conditions set forth therein.

11 21. Should RIT initiate a lawsuit against Fire Innovations and/or Fire Innovations'
12 customer for infringement of any of the patents asserted in the now dismissed action in Ohio,
13 RIT would again be filing an action without a reasonable basis in law or fact to support its
14 allegations of infringement of any of the patents in suit, and its only purpose in doing so would
15 be to vex, harass, annoy, and burden Fire Innovations and Fire Innovations customers for the
16 purpose of chilling transactions between Fire Innovations and its customers and prospective
17 customers.

18 22. Despite the lack of a basis in law or fact for pursuing its claims, and based on RIT's
19 statements to plaintiff and to the Court in Ohio, Fire Innovations is informed and believes that
20 RIT does intend to file such a suit. For this reason, a case of actual controversy within this court's
21 jurisdiction exists between Fire Innovations and RIT with respect to the validity, infringement,
22 and enforceability of the above-identified patents in suit.

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1 FIRST CAUSE OF ACTION
2 DECLARATION OF NON-INFRINGEMENT OF THE '571 PATENT

3 23. Fire Innovations realleges and incorporates by reference all of the allegations of
4 paragraphs 1 through 22, as if set forth fully herein.

5 24. Fire Innovations does not make, use, sell, offer for sale, or import for sale any
6 product that infringes any claim of the '571 patent, either directly or indirectly, literally or under
7 the doctrine of equivalents.

8 25. As and for a First Cause of Action, Fire Innovations therefore seeks a judicial
9 determination and a declaratory judgment that Fire Innovations does not infringe, either directly
10 or indirectly, literally or under the doctrine of equivalents, the claims of the '517 patent. Such a
11 determination and declaration are necessary and appropriate at this time so that the parties may
12 ascertain their respective rights and duties regarding the '517 patent.

13 SECOND CAUSE OF ACTION
14 DECLARATION OF INVALIDITY OF THE '517 PATENT

15 26. Fire Innovations realleges and incorporates by reference all of the allegations of
16 paragraphs 1 through 25, as if set forth fully herein.

17 27. On information and belief, the '517 patent, and each claim thereof, are invalid for
18 failure to comply with the conditions and requirements of patentability set forth in Title 35 of the
19 United States Code, particularly 35 U.S.C. §§ 101 et seq., including, but not limited to 35 U.S.C.
20 §§ 101, 102, 103 and 112.

21 28. On information and belief, the '571 patent, and each claim thereof, are limited in
22 scope, and are invalid and void, for the following reasons:

23 a. The alleged invention was known or used by others in this country, or patented
24 or described in a printed publication in this or a foreign country, before the alleged invention
25 thereof by the applicant for such patent;

1 b. The alleged invention was patented or described in a printed publication in this
2 or a foreign country or in public use or on sale in this country, more than one year prior to the
3 date of the application for such patent in the United States;

4 c. The alleged invention was described in a patent granted on an application for
5 patent by another filed in the United States before the alleged invention thereof by the applicant
6 for such patent, or on an international application by another who fulfilled the requirements of
7 paragraphs (1), (2), and (4) of section 371(c) of 35 United States Code before the alleged
8 invention thereof by the applicant for such patent;

9 d. The applicant for such patent did not himself invent the subject matter sought
10 to be patented;

11 e. Before the applicant's alleged invention thereof, the invention was made in this
12 country by another who had not abandoned, suppressed, or concealed it;

13 f. Any differences between the subject matter of the claims of such patent and the
14 prior art are such that the subject matter as a whole would have been obvious at the time the
15 alleged invention was made to a person having ordinary skill in the art to which the subject
16 matter pertains;

17 g. The specification of such patent does not contain a written description of the
18 alleged invention and of the manner and process of making and using it, in such full, clear,
19 concise, and exact terms as to enable any person skilled in the art to which it pertains, or with
20 which it is most nearly connected, to make and use the same, and does not set forth the best mode
21 contemplated by the applicant for carrying out his invention;

22 h. The claims of such patent are functional, vague, and indefinite, are broader
23 than the alleged invention as set forth in the specification, and do not particularly point out and
24 distinctly claim the subject matter, which applicant regards as his alleged invention;